



Docket No.: 211739US0X

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ATTORNEYS AT LAW

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

RE: Application Serial No.: 09/919,854
Applicants: Mike FARWICK, et al.
Filing Date: August 2, 2001
For: NUCLEOTIDE SEQUENCES WHICH CODE FOR
THE SAHH GENE
Group Art Unit: 1652
Examiner: Christian Fronda

SIR:

Attached hereto for filing are the following papers:

Response to Requirement for Restriction

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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DOCKET NO: 211739US0X

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

MIKE FARWICK, ET AL.

SERIAL NO: 09/919,854

FILED: AUGUST 2, 2001

FOR: NUCLEOTIDE SEQUENCES
WHICH CODE FOR THE SAHH GENE

:

: EXAMINER: FRONDA, CHRISTIAN

:

: GROUP ART UNIT: 1652

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RESPONSE TO REQUIREMENT FOR RESTRICTION

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Office Action dated June 30, 2003, Applicants elect, with traverse, Group I, Claims 1-7 and 18, drawn to an isolated polynucleotide, vector, and host cell.

REMARKS

- Group I: Claims 1-7, and 18, drawn to an isolated polynucleotide, vector, and host cell;
- Group II: Claim 8, drawn to a *Corneform* bacterium in which the *sahH* gene is enhanced;
- Group III: Claims 10-17, 19 and 20, drawn to a process for producing L-amino acids;
- Group IV: Claims 21-32, drawn to a process for preparing L-methionine-containing animal feeds;
- Group V: Claims 33 and 34, drawn to an animal feedstuff additive; and
- Group VI: Claim 35, drawn to a process for identifying RNA, cDNA and DNA using hybridization probes.

Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct. The burden of proof is on the Office to provide reasons and/or examples to support any conclusion with regard to patentable distinctness. MPEP §803.

Applicants respectfully traverse the requirement for restriction on the grounds that the Office has not provided adequate reasons and/or examples to support a conclusion of patentable distinctness between the identified groups.

Citing MPEP §§806.04 and 808.01, the Office has characterized Groups I, II and V as "unrelated" inventions. However, Applicants note that the MPEP describes unrelated inventions as, for example, "an article of apparel such as a shoe, and a locomotive bearing", or "a process of painting a house and a process of boring a well." MPEP 806.04(A). Thus, unrelated inventions, as defined by the MPEP, are inventions which are directed to *completely* different technical fields, and have no reasonable relationship with each other. Applicants make no statement regarding the patentable distinctness, but note that Groups I-II are classified in class 435. Therefore these groups can be reasonably searched in the same technical field and do not meet the standard of "unrelatedness" of MPEP 806.04(A), discussed above, nor do they present a burden on the Office. Accordingly, Applicants respectfully submit that the Restriction is improper, and request that it be withdrawn.

In regard to Groups III, IV, and VI, the Office has characterized these groups as unrelated. Citing MPEP §§806.04 and 808.01, the Office suggests that "the methods of Groups III, IV, and VI are distinct both physically and functionally; require different process steps, reagents, and parameters; and produce different products." However, Applicants respectfully submit that the Office has merely made a conclusion, and has not provided examples/explanation to suggest that these Groups are unrelated, as alleged. Accordingly, Applicants respectfully submit that the restriction requirement is improper, and it should therefore be withdrawn.

The Office has characterized Groups I, III, IV, V and VI as unrelated. Citing MPEP §§806.04 and 808.01, the Office suggests that "each of the processes of Groups III, IV, and VI do not require the products of Groups I and V." However, Applicants respectfully submit that the Office has merely made a conclusion, and has not provided any examples or explanation whatsoever. Accordingly, Applicants respectfully submit that the restriction requirement is improper, and it should therefore be withdrawn.

In regard to Groups II and III/IV, the Office has characterized the relationship between these groups as product and process of use. Citing MPEP §806.05(h), the Office concludes that the product as claimed can be used in a materially different process "such as using cornyeform bacteria in a recombinant process for the production of the enhanced sahH protein." However, there is no evidence of record to show that the claimed product can be made as alleged by the Office. Applicants respectfully submit that the Office has not shown how the alleged process is materially different from the claimed process. Accordingly, Applicants respectfully request withdrawal of the Requirement for Restriction.

Further, Applicants respectfully traverse the Requirement for Restriction on the grounds that the Office has not shown that a burden exist in searching all of the claims. Applicants respectfully point out Groups I-IV and VI are in classified in class 435, and could be searched together.

Finally, Applicants note that MPEP §821.04 states, "if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined." Applicants respectfully submit that should the elected group be found allowable, the non-elected claims should be rejoined.

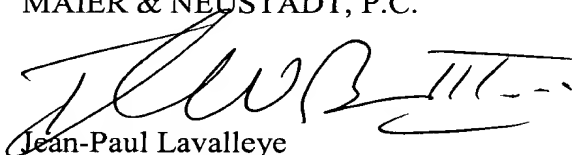
Application No. 09/913,854
Reply to Office Action of June 30, 2003

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Requirement for Restriction. Withdrawal of the Requirement for Restriction is respectfully requested.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
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